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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,384	01/16/2001	Arthur G. Duppsadt	049440-00004	4769

3705 7590 09/17/2002

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,384

Applicant(s)

DUPPSTADT, ARTHUR G.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 17-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-16 in Paper No. 4 is acknowledged.

Claim Rejections - 35 USC § 112

Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, claim 16 is claiming a "contact lens" that is also a surgically implantable lens (presumably like an intraocular lens) and it is not clear how the lens can be both a contact lens and an intraocular lens which is not supported by the specification creating the lack of enablement.

Claims 1, 10, 12 and 14-15 (and dependent claims 2-9, 11,13 and 16) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to claim 1, that part of the claim stating "a spherical portion disposed radially adjacent to said central portion" renders the claim vague and indefinite because it is not clear if applicant intended to claim "radially adjacent to said aspheric portion" or if applicant intended to claim that the aspherical portion is located in the center of the lens. The lack of clarity renders the claim vague and indefinite. For purposes of examination the assumed meaning is "radially adjacent to said aspheric portion" due to

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claim 3, which depends from claim 1 and claims that the spherical portion (and not the aspheric portion) is at the center of the lens.

In reference to claim 10 and 12, the claims state, "said aspherical central portion" and are vague and indefinite for the same reasoning set forth as to claim 1 above. For purposes of examination the assumed meaning is "said aspherical portion" (with "central" being omitted).

In reference to claims 14 and 15, claiming that the lens has "only one said aspherical central portion and one said annular spherical portion" (and the similar language with reference to claim 15) renders the claims vague and indefinite. Specifically, any lens that has an aspheric central portion will inherently have just one central portion and therefore will inherently have just one aspheric central portion. The same reasoning applies to the annular spherical portion as well as to the similar limitations within claim 15. Therefore, it is not clear if applicant is claiming that the lens has just one aspheric portion, just one aspheric portion that provide distance correction, just one distance correction portion etc. (with similar clarity issues concerning the annular spherical portion and the similar limitations within claim 15) and the lack of clarity renders the claims vague and indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1, 3, 9, 12-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Muckenhirn et al.

Muckenhirn et al reads on these claims by disclosing the limitations therein including the following: a multifocal contact lens (abstract); comprising an inner concave and an outer convex surface (Figure 2); an aspheric portion structured to provide distant vision (Figures 1 and 2, "2", column 1, line 49 and claim 1); a spherical portion disposed radially adjacent to the central portion (Figures 1 and 2, "1", column 1, line 54); this spherical portion providing reading vision (column 1, line 54 re "near zone 1"); the spherical portion in the center of the lens and the aspherical portion of annular shape and surrounding the spherical portion (Figure 1); the aspherical and spherical portions formed on the outer surface of the lens (Figure 2); and the lens having only one central spherical portion and annular aspheric portion (Figures 1 and 2 to the extent this claim is understood). The lens of Muckenhirn et al will inherently be transparent, this being reasonably based upon it being well known that corrective contact lenses are transparent in order to provide optimal viewing correction. The lens of Muckenhirn et al will inherently provide simultaneous distant and reading vision, this being reasonably based upon it being well known that bifocal contact lenses formed of concentric annular

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zones, similar to Muckenhirn et al, provide the optical correction through the use of "simultaneous vision" correction.

Claims 1-2, 9 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Seidner et al.

Seidner et al reads on these claims by disclosing the limitations therein including the following: a multifocal contact lens (abstract); comprising an inner concave and an outer convex surface (Figure 2); an aspheric portion structured to provide distant vision (Figure 2, "18", column 8, line 52); a spherical portion disposed radially adjacent to the central portion (Figure 2, "12", column 8, line 59). Furthermore, in reference to the "radially adjacent", in column 13, line 8, "24" of Figure 1 is described as a transition junction where surface 12 meets surface 18 and therefore these two surfaces are "radially adjacent" to each other. Seidner et al further discloses this spherical portion providing reading vision (column 8, line 59); the aspherical portion in the center of the lens and the spherical portion of annular shape and surrounding the aspherical portion (Figures 1-2). Seidner et al further discloses the spherical and aspherical portions on the outer surface of the lens (Figure 2) and the lens having only one central spherical portion and annular aspheric portion (Figure 2 to the extent this claim is understood). The lens of Seidner et al will inherently be transparent, this being reasonably based upon it being well known that corrective contact lenses are transparent in order to provide optimal viewing correction. The lens of Seidner et al will inherently provide simultaneous distant and reading vision, this being reasonably based upon it being well

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known that bifocal contact lenses formed of concentric annular zones, similar to Seidner et al, provide the optical correction through the use of "simultaneous vision" correction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5, 8, 10-11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidner et al in view of Portney.

In reference to these claims, Seidner et al discloses as is set forth above but discloses the corrective portions on the outer surface and not on the inner surface as claimed. Portney teaches that in a multifocal contact lens comprising annularly concentric near and distant correction portions (abstract, Figure 3A, column 8, lines 40-61), similar to Seidner et al, that the corrective portions can be formed on either the inner or outer surface of the lens to provide the desired optical correction (column 8, line 60, column 5, lines 54-60). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the corrective portions of Seidner et al formed on the inner surface of the lens since Portney teaches that in a multifocal contact lens comprising annularly concentric near and distant correction portions, that the corrective portions can be formed on either the inner or outer surface of the lens to provide the desired optical correction. In reference to claim 5, since the claimed "outward portion" has substantially the same radius as the

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spherical portion, then the innermost portion of the spherical portion "12" of Figure 2 can be considered this "outward portion" of the aspherical portion. It is believed that the contact lens of Seidner et al will inherently have the minimum thickness as claimed in claim 8, this being reasonably based upon what is disclosed in Seidner et al.

In reference to claim 16, Seidner et al discloses the lens as a contact lens but not as a surgically implantable lens. Portney teaches that a multifocal lens comprising annularly concentric near and distant correction portions (abstract, Figure 3A, column 8, lines 40-61), similar to Seidner et al can be adapted to be in the form of either a contact lens or an intraocular lens i.e. a "surgically implantable lens" depending upon the intended user of the lens (abstract, column 5, lines 20-60 and column 8, lines 40-60). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the contact lens of Seidner et al adapted for use as a surgically implantable lens since Portney teaches that a multifocal lens comprising annularly concentric near and distant correction portions can be adapted to be in the form of either a contact lens or an intraocular lens i.e. a "surgically implantable lens" depending upon the intended user of the lens.

Prior Art Citations

Mercure is being cited herein to show a contact lens that would read on or make obvious a number of the above rejected claims, however, such rejections would have been repetitive.

Allowable Subject Matter

Claims 6-7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to claims 6-7, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, none of the prior art either alone or in combination disclose or teach of the claimed multifocal contact lens comprising an aspheric portion structured to provide distant vision, a spherical portion structured to provide reading vision, the spherical portion disposed radially adjacent the aspherical portion, the aspheric portion disposed within the center of the lens with the spherical portion of annular shape and surrounding the aspheric portion, the aspheric portion and spherical portion formed within the inner concave surface, and specifically further with the aspherical central portion having a diameter as claimed or the annular spherical portion having a width as claimed.

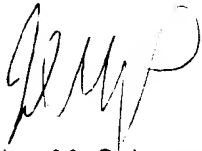
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read 'JMS', is positioned above the printed name.

Jordan M. Schwartz
Primary Examiner
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September 12, 2002